



Paper No. 14

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Texas Instruments Incorporated
P.O. Box 655474, M/S 3999
Dallas, TX 75265

In re Application of
Chen, *et al.*
Application No. 09/115,444
Filed: July 14, 1998
Attorney Docket Number: TIS-25912

OFFICE OF PETITIONS

:
: **DECISION REFUSING STATUS**
: **UNDER 37 C.F.R. §1.47(a)**
:

This is in response to the November 12, 1998 petition Under 37 C.F.R. §1.47(a). The office sincerely apologizes for the delay.

HISTORY

Applicant filed the above-identified application on July 14, 1998, naming Fung Leng Chen, Chee Kiang Yew, and Pang Hup Ong as joint inventors. However, the application as filed did not include the declaration executed as required by 37 C.F.R. §1.53. Specifically, the declaration lacked the signature of co-inventor Ong.

On August 20, 1998, the Office of Initial Patent Examination mailed a notice to file missing parts (hereinafter "the notice") to the address of record. A two month extendable deadline was set for filing a reply.

Petitioner filed this reply on November 12, 1998, which with the included one month extension of time request, was timely.

LAW

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(l) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

ANALYSIS

Petitioner has failed to demonstrate that the nonsigning inventor has been provided with a complete copy of the application. In fact, Petitioner has nowhere even alleged that such a step was taken.

Here, Petitioner alleges that assignment and declaration forms were mailed to Texas Instruments Singapore for the purpose of obtaining the nonsigning inventor's signature.

First, the office has no information as to why this would constitute delivery of the declaration and assignment to the nonsignor, since there is no connection established in this petition between the nonsignor and Texas Instruments Singapore.

Second, even if a connection is established between Texas Instruments Singapore and the nonsignor, such a means of delivery has not been established as being reliable. Petitioner is urged to consider that for rule 47 purposes, the last known address is the one at which the non-signing inventor customarily receives mail.¹ Ordinarily, that address is the non-signing inventor's residential address.² Because the declaration and assignment were sent to Texas Instruments Singapore, it is unclear whether the application has been reliably delivered to the nonsignor. Furthermore, because of this ambiguity, it cannot be decided with certainty that the nonsignor has refused to sign the declaration after having been presented with the opportunity to review the application.

Third, even with the above notwithstanding, there is no evidence to support the satisfaction of the requirement of giving the nonsigning inventor a bona fide opportunity to sign the declaration because it appears as though only the declaration and assignment were mailed to Texas Instruments Singapore. Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.³ Under the provisions of 37 C.F.R. §1.63(b)(2), a valid declaration must "state that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration." Thus, an inventor cannot make a valid declaration without having had the opportunity to review the application papers. This is why the Office requires that a copy of the papers be sent or delivered to the nonsignor before rule 47 status will be granted. Simply put, an inventor must be given the opportunity to review the entire application before a valid declaration can be made. Until such time as the application has been sent or delivered to the nonsignor, it cannot be said that the inventor has been given a *bona fide* opportunity to make the required declaration.

Accordingly, before this petition can be granted, Petitioner must show that 1) the entire application 2) was sent or delivered to the inventor at the address at which the nonsigning inventor customarily receives mail.

Petitioner is advised to consult the M.P.E.P. §409.03(d) for further information on what kind of showing is required to prove that the nonsigning inventor has refused to sign the declaration.

Because of the foregoing, this petition is *dismissed*.

¹ M.P.E.P. §409.03(e)

² *Id.*

³ M.P.E.P. §409.03(d)

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.47(a)".

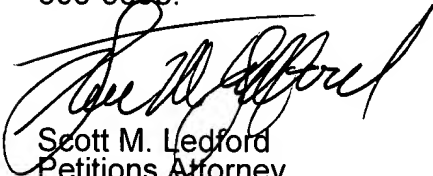
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-5593.



Scott M. Ledford
Petitions Attorney
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects